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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/898,806 | 07/03/2001 | Koki Kanda | 0941.65658 | 5709 |

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| EXAMINER |
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KLIMOWICZ, WILLIAM JOSEPH

| ART UNIT | PAPER NUMBER |
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2652

16

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,806

Applicant(s)

KANDA ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19,22 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19,22 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 19, 22 and 27-29 are currently pending.

Claims 1-18, 20, 21, 23-26 have been voluntarily cancelled by the Applicants.

The Applicants have elected Species I (corresponding to FIGS. 3A and 3B) *without* traverse in Paper No. 15 (filed April 12, 2004). The Applicants contend that pending claims 19, 22 and 27 read thereon.

Non-elected claims 28 and 29 have been withdrawn from consideration as being drawn to non-elected Species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsuzaki (JP 03-132910 A).

As per claim 19, Matsuzaki (JP 03-132910 A) discloses a magnetic head comprising: a slider (1) having a rail (11,12) with a top surface; a thin-film element part (2) to write and read information, formed on an end of said rail top surface of said slider (1); and a protective film (3) formed on said thin-film element part (2) and defining a distal end of the rail (e.g., FIG. 5)

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whereby air exits said slider (1) at said distal end, said protective film (3) having a recess (111,112/121,122) which extends from said thin-film element part (2) towards said distal end, said recess (111,112/121,122) being lower than said rail top surface (FIGS. 2 or 6) and having a width defined by a width of said rail (11/12). That is, the recess (111,112/121,122) extends the entire length of the rail, and thus as a subset, must also extend from the thin-film element part (2) toward the distal end of the slider. Thus, although the recess has a dimension which extends laterally of the rail, it also has a dimension which extends toward the distal end of the rail since it indeed extends the length of the slider; such recess (111,112/121,122) having a width defined by the rail width. If the rail width were shorter, the recess (111,112/121,122) would be longer; if the rail width were longer, the recess would correspondingly be shorter.

Additionally, as per claim 27, the recess (111,112/121,122) has a top surface substantially parallel to said rail top surface - see FIG. 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki (JP 03-132910 A).

See the discussion of Matsuzaki (JP 03-132910 A), *supra*.

As per claim 22, Matsuzaki (JP 03-132910 A) shows a slider for use in a conventional

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magnetic disk apparatus, but does not explicitly depict such a conventional magnetic disk apparatus, including conventional elements such as a head supporting part for carrying the magnetic head to enable said head to float over a recording medium; an arm part on which said head supporting part is fitted; and a driving part for moving said arm part over said recording medium.

Official notice is taken that such conventional magnetic disk apparatuses which the conventional component parts recited in claim 22 are notoriously old and well known and ubiquitous in the art; such Officially noticed fact being capable of instant and unquestionable demonstration as being well-known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the magnetic head slider of Matsuzaki (JP 03-132910 A) within a conventional magnetic disk apparatus set forth in claim 22.

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the magnetic head slider of Matsuzaki (JP 03-132910 A) within a conventional magnetic disk apparatus set forth in claim 22 in order to provide the magnetic head slider of Matsuzaki (JP 03-132910 A) within its intended operating environment, thereby providing the self-evident advantages of the slider of Matsuzaki (JP 03-132910 A) ("floating quantity can be reduced") within a conventional magnetic disk apparatus.

Response to Arguments

Applicants' arguments filed January 29, 2004 have been considered, but are deemed nonpersuasive.

The Applicants allege that Matsuzaki (JP 03-132910 A) fails to disclose the claimed recess, as now set forth in the amended claims, since the recess (111, 112, 121, 122) extend in "a direction perpendicular to the longitudinal direction of the rail."

See Applicants' arguments at page 4.

As set forth in the rejection, *supra*, Matsuzaki (JP 03-132910 A) discloses a recess (111,112/121,122) which extends from said thin-film element part (2) towards said distal end. The recess (111,112/121,122) is lower than said rail top surface (FIGS. 2 or 6) and having a width defined by a width of the rail (11/12). That is, the recess (111,112/121,122) extends the entire length of the rail, and thus as a subset, must also extend from the thin-film element part (2) toward the distal end of the slider. Thus, although the recess has a dimension which extends laterally of the rail, it *also* has a dimension which extends toward the distal end of the rail since it indeed extends the length of the slider; such recess (111,112/121,122) having a width defined by the rail width. If the rail width were shorter, the recess (111,112/121,122) would be longer; if the rail width were longer, the recess would correspondingly be shorter. Nothing in the invention, as presently claimed, requires the recess to commence from behind the thin-film element part toward the distal end, such recess being defined by the width of the rail and having a dimension corresponding to the rail width.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

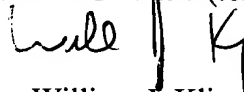
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William J. Klimowicz
Primary Examiner
Art Unit 2652

WJK